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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/575,749

05/22/2000

William P. Alberth Jr.

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1184

7590

12/30/2005

Motorola Inc
Intellectual Property Dept(BMM)
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EXAMINER

SHIN, KYUNG H

ART UNIT

PAPER NUMBER

2143

DATE MAILED: 12/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/575,749

Applicant(s)

ALBERTH JR. ET AL.

Examiner

Kyung H. Shin

Art Unit

2143

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 November 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

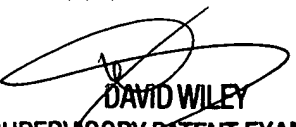
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-19.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.


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Continuation of 11. does NOT place the application in condition for allowance because: Response to Remarks

1.1 Applicant argues that the referenced prior art does not disclose: "... what the divided authorization is used for ..." (see Remarks) The divided authorization is used for the same function as the usage of a two part smart card (see Applicant's Specifications Pages 2-3). The division of authorization provides the capability for increased security within a smart card system.

1.2 Applicant argues that the referenced prior art discloses "... processing operation in combination with one or several microcircuit cards ... exact opposite of the claimed granting access to data only when a second device is operatively coupled to the first device ..." (see Remarks)

The Storck (5,434,395) prior art discloses that if the only embodiment of the prior art utilized is the generation of split authorization between two smart cards only, then the claimed limitation is met. Therefore, the Storck (5,434,395) prior art discloses that smart card data transfer transactions can only be performed when a first smart card is operatively coupled to a second smart card.

1.3 Applicant argues that the referenced prior art does not disclose: "... first or second personal data storage device is accessible and usable only when first and second personal data storage devices are in communication with each other ..." (see Remarks) and the smart card data is inaccessible when not in use.

The Storck (5,434,395) prior art discloses that data is not accessible and not usable when two specific carriers (personal data storage devices) are not in communication with each other. (see Storck col. 4, lines 52-58: the data is not accessible and usable (i.e. cannot be read without authorization such as the input of a personal identification number code) whether two specific carriers (i.e. personal data storage devices) are in communication with each other)

The Storck (5,434,395) prior art discloses that authorization is required in order to perform data access transactions on a data carrier (i.e. smart card), therefore access is not allowed without or before the completion of the authorization process. (see Storck col. 4, lines 52-58: authentication (i.e. code) is required in order to access data on the card)

In addition, the Storck (5,434,395) prior art discloses the capability to split authorization utilizing two smart cards. This procedure dictates the coupling (i.e. operative coupling) of two data carriers is required (i.e. smart cards) to complete authorization and remaining coupled for operation. No disclosure is stated requiring that the smart cards are uncoupled after authorization. (see Storck col. 12, lines 45-48: Two data carriers (i.e. smart cards) must be used together (i.e. coupled together) in order to complete authorization and access the data on the card.) By definition, complimentary is defined as "... forming a complement ; completing ... ; ... complementing each other ... ". (1. (1997). The New Webster's Encyclopedia Dictionary of the English Language.

NY : Random House Value Publishing, Inc. ISBN 0-517-18367-6)

or "... forming or serving as a complement ; completing. ... "
(2. <http://www.answers.com/complementary&r=67>)

The two cards must operate together in order to complete authorization and for subsequent data transfer operations.

Once authorization has been completed, the Storck (5,434,395) prior art discloses transferring data between data carrier devices (i.e. smart cards). (see Storck col. 4, line 52-58; col. 4, line 31-34: Principal objective of prior art is to transfer data (i.e. transaction) between a first and a second data carrier (i.e. smart cards) - "... transferring data from one of said carriers to the other during a transaction between said first and second carriers ... ")

1.4 Applicant argues that the referenced prior art does not disclose: "... granting access to a third device to said personal data therein only when a second data storage device is operatively coupled to a first data storage device ..." (see Remarks)

In the previous response, the Storck (5,434,395) prior art discloses the capability to have two smart cards operatively coupled together. The Storck (5,434,395) prior art discloses that data is accessible and usable (i.e. valid authorization to access data) to a third device only when the first and second personal data storage devices are in communication with each other. (see Storck col. 5, lines 8-15: Data can only be transferred between a first and a second personal data storage device when the first personal data storage device is authorized or operating at a pre-defined authorization level, to send data) ; col. 4, lines 31-34; col. 5, line 64 - col. 6, line 9: Data can be transferred between a first and second personal data storage devices coupled together for authorization and a third device for data transfer); col. 12, lines 45-48: The authorization level is divided between two personal data storage devices such that data transfers to a third device is possible only when a first and a second personal data storage device are coupled together or are used simultaneously (e.g. operatively coupled, operating at the same time).

1.5 Applicant argues that the referenced prior art does not disclose: "... a three party transaction between multiple devices ..." (see Remarks), access to third card only when two cards (card one and card two) are operatively coupled.


The Storck (5,434,395) and Kramer (6,324,525) prior art combination discloses transactions utilizing smart card technology with three devices interconnected for the completion of transactions through network communications. Two of the smart cards are required for authorization and the third smart card is required for data transfers. (see Kramer col. 4, lines 57-65; col. 140, lines 39-42: three party transactions) Two cards operatively coupled together has been previously disclosed. The third (i.e. one of the three) smart card is a vendor device as stated in applicant remarks. (see Remarks Page 7, Lines 8-9: "... as a terminal of a vendor ... compatible data equipment of the vendor ... ") The Storck (5,434,395) and Kramer (6,324,525) prior art combination discloses one of the three devices is a vendor device. The designation of a vendor device as one of transaction devices indicates Electronic Commerce, which is based on data transfers between devices interconnected over a communication network. The Storck (5,434,395) prior art discloses operation in an e-commerce (i.e. analogous data transfer) type environment.

1.6 Applicant argues that the secondary reference and primary reference combination under 35 U.S.C. § 103 is not allowed due to nonobviousness.

The test for obviousness is not whether the features of a secondary ₂ reference may be bodily incorporated into the structure of the

primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Furthermore, in response to applicant's arguments against the reference individually, one cannot show nonobviousness by attacking references individually where rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986)..

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